

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed August 25, 2004. At the time of the Office Action, Claims 1-3, 6-15, and 18-22 were pending in the Application. Applicant amends Claims 1, 11-15, and 18-22. It is important to note that the amendments are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues, only further clarify subject matter already present, and have been made only to advance the prosecution of this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

In the Drawings

The Application was filed with informal drawings that are acceptable for examination purposes. Formal drawings for the Application have been appended to this Response. Additionally, the Examiner offered a reminder to the Applicant that FIGURE 1 and FIGURE 2 should be designated by a legend such as --Prior Art-- because that which is old is illustrated. Applicant has amended FIGURE 1 and FIGURE 2 to provide this indication and thereby resolved the Examiner's concern. Applicant submits that the formal drawings do not add any new matter to the Application and are in full compliance with 37 U.S.C. §1.81, §1.83, and §1.84.

The Abstract

The Examiner objects to the abstract of the disclosure because of the missing parenthesis for the acronym 'SDU' in the first line. Applicant apologizes for this clerical mistake and has amended the specification in order to address the Examiner's concern.

Section 112 Rejections

The Examiner rejects Claims 1-3, 6-15, and 18-22 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner rejects Claims 14-15 and 18-22 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner also asserts that Claims 14-15 and 18-22 recite the limitation "the apparatus" in the first line and that there is insufficient antecedent basis for this limitation in the

claims. Applicant has made a number of amendments to these claims in order to address the Examiner's concerns.

Section 102 Rejection

The Examiner rejects Claims 1-3, 6, 11-15, and 18 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,353,742 issued to Bach (hereinafter "*Bach*"). Applicant respectfully traverses this rejection for the following reasons.

Independent Claim 1, as amended, recites directing reverse communication traffic associated with the selected mobile station to a selected one or more of the plurality of base transceiver stations, wherein a selection and distribution unit determines which base transceiver station is to accommodate an associated communication session based on a selected one of a signal strength associated with the selected mobile station and a predicted position associated with the selected mobile station. [Note that proper support for this amendment can be readily found at page 14: lines 3-14 of the current specification.]

Applicant reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³

Using this jurisprudence, *Bach* cannot anticipate Independent Claim 1. For example, *Bach* fails to teach, suggest, or disclose a selection and distribution unit that determines which base transceiver station is to accommodate an associated communication session based on a selected one of a signal strength associated with the selected mobile station and a predicted position associated with the selected mobile station, as recited in Independent Claim 1. Indeed, *Bach* fails to disclose any information relating to signal strength or predicted positioning, as the disclosed architecture of *Bach* behaves in a different manner than that which is claimed in

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

Independent Claim 1. Because *Bach* fails to teach, suggest or even remotely disclose this limitation, *Bach* is precluded from inhibiting the patentability of Independent Claim 1.

Claims 2-3 and 6-10 depend from Independent Claim 1 and are, therefore, also allowable over *Bach* for similar reasons. In addition, Independent Claims 11, 12, and 13 include a similar limitation and are allowable for analogous reasons. Moreover, the dependent claims of Independent Claim 13 are also allowable over *Bach* using similar reasoning.

Section 103 Rejection

The Examiner rejects Claims 7-10 and 19-22 under 35 U.S.C. §103(a) as being unpatentable over *Bach* in view of U.S. Patent No. 6,141,347 issued to Shaughnessy et al. (hereinafter “*Shaughnessy*”). Applicant respectfully traverses this rejection for the following reasons.

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.⁴

It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. This prong of the §103 analysis has been evaluated thoroughly above in the tendered §102 analysis. Furthermore, Applicant notes that the *Shaughnessy* reference, also cited by the Examiner in his §103 rejection, fails to offer any additional disclosure combinable with *Bach*, which would inhibit the patentability of any of the pending claims. The *Shaughnessy* reference is engaged in multicast addressing (See abstract of *Shaughnessy*), but fails to implement any such operations in the context of receiving signal strength information or predicted position information. For at least these reasons, the pending claims are patentably distinct from both *Shaughnessy* and *Bach* and any combination thereof.

⁴ See M.P.E.P. § 2142-43.

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Therefore, all of the pending claims have been shown to be allowable, as they are patentable over the proposed references. Formal notice to this effect is respectfully requested in the form of a full allowance of all the pending claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Although Applicant believes that no fee is due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
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